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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/512,736 02/24/00 HEIN

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HM22/0705

EXAMINER

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BUI, P

ART UNIT

PAPER NUMBER

1638

DATE MAILED:

07/05/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

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<b>Office Action Summary</b>	Application No. <b>09/512,736</b>	Applicant(s) <b>Hein et al.</b>	Examiner <b>Phuong Bui</b>	Art Unit <b>1638</b>	
<i>-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --</i>					
<b>Period for Reply</b>					
<p>A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.</p>					
<ul style="list-style-type: none"> <li>- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.</li> <li>- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.</li> <li>- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.</li> <li>- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).</li> <li>- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).</li> </ul>					
<b>Status</b>					
<p>1) <input checked="" type="checkbox"/> Responsive to communication(s) filed on <u>Feb 24, 2001</u></p>					
<p>2a) <input type="checkbox"/> This action is FINAL.      2b) <input checked="" type="checkbox"/> This action is non-final.</p>					
<p>3) <input type="checkbox"/> Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under <i>Ex parte Quayle</i> 1035 C.D. 11; 453 O.G. 213.</p>					
<b>Disposition of Claims</b>					
<p>4) <input checked="" type="checkbox"/> Claim(s) <u>21-66</u> is/are pending in the application.</p>					
<p>4a) Of the above, claim(s) _____ is/are withdrawn from consideration.</p>					
<p>5) <input type="checkbox"/> Claim(s) _____ is/are allowed.</p>					
<p>6) <input type="checkbox"/> Claim(s) _____ is/are rejected.</p>					
<p>7) <input type="checkbox"/> Claim(s) _____ is/are objected to.</p>					
<p>8) <input checked="" type="checkbox"/> Claims <u>21-66</u> are subject to restriction and/or election requirement.</p>					
<b>Application Papers</b>					
<p>9) <input type="checkbox"/> The specification is objected to by the Examiner.</p>					
<p>10) <input type="checkbox"/> The drawing(s) filed on _____ is/are objected to by the Examiner.</p>					
<p>11) <input type="checkbox"/> The proposed drawing correction filed on _____ is: a) <input type="checkbox"/> approved b) <input type="checkbox"/> disapproved.</p>					
<p>12) <input type="checkbox"/> The oath or declaration is objected to by the Examiner.</p>					
<b>Priority under 35 U.S.C. § 119</b>					
<p>13) <input type="checkbox"/> Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).</p>					
<p>a) <input type="checkbox"/> All b) <input type="checkbox"/> Some* c) <input type="checkbox"/> None of:</p>					
<p>1. <input type="checkbox"/> Certified copies of the priority documents have been received.</p>					
<p>2. <input type="checkbox"/> Certified copies of the priority documents have been received in Application No. _____.</p>					
<p>3. <input type="checkbox"/> Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).</p>					
<p>*See the attached detailed Office action for a list of the certified copies not received.</p>					
<p>14) <input type="checkbox"/> Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).</p>					
<b>Attachment(s)</b>					
<p>15) <input type="checkbox"/> Notice of References Cited (PTO-892)</p>					
<p>16) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)</p>					
<p>17) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____</p>					
<p>18) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____</p>					
<p>19) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)</p>					
<p>20) <input type="checkbox"/> Other: _____</p>					

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## **DETAILED ACTION**

### ***Election/Restriction***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 21-30 and 49-52, drawn to plant cells containing nucleotide sequences encoding both heavy and light chain immunoglobulin polypeptides, classified in class 800, subclass 288.
  - II. Claims 31-48, drawn to plant cells containing nucleotide sequences encoding heavy chain immunoglobulin polypeptides, classified in class 800, subclass 288.
  - III. Claims 53-66, drawn to plant cells containing nucleotide sequences encoding light chain immunoglobulin polypeptides, classified in class 800, subclass 288.

2. The inventions are distinct, each from the other because of the following reasons:

Inventions I and (II & III) are related as combination and subcombinations. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the combination recites 2 distinct subcombinations, the immunoglobulin heavy chain nucleotide sequence and the immunoglobulin light chain nucleotide sequence. Since both of these subcombinations is separately claimed, each serves as evidence that the other subcombination

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when combined is not the sole basis for patentability of the combination. The subcombination has separate utility such as for the production of immunoglobulin heavy chain or light chain.

3. Because these inventions are distinct for the reasons given above and the literature search required for one Group is not required for another Group, restriction for examination purposes as indicated is proper.

4. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

6. Papers relating to this application may be submitted to Technology Sector 1 by facsimile transmission. Papers should be faxed to Crystal Mall 1, Art Unit 1638, using fax number (703) 308-4242. All Technology Sector 1 fax machines are available to receive transmissions 24 hrs/day, 7 days/wk. Please note that the faxing of such papers must conform with the Notice published in the Official Gazette, 1096 OG 30, (November 15, 1989).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Phuong Bui whose telephone number is (703) 305-1996. The Examiner can normally be reached Monday-Friday from 6:30 AM - 4:00 PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Paula Hutzell, can be reached at (703) 308-4310.

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Any inquiry of a general nature or relating to the status of this application should be directed to the receptionist whose telephone number is (703) 308-0196.

Phuong Bui  
Primary Examiner  
Group Art Unit 1638  
June 25, 2001



PHUONG T. BUI  
PRIMARY EXAMINER